

**IRELL & MANELLA LLP**

Morgan Chu (#70446)

mchu@irell.com

1800 Avenue of the Stars

Los Angeles, CA 90067

Telephone: (310) 277-1010

Facsimile: (310) 203-7199

David C. McPhie (#231520)

dmcphie@irell.com

Kamran Vakili (#284441)

kvakili@irell.com

840 Newport Center Drive, Suite 400

Newport Beach, CA 92660

Telephone: (949) 760-0991

Facsimile: (949) 760-5200

*Attorneys for Plaintiff Audatex North  
America, Inc.*

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

AUDATEX NORTH AMERICA, INC., )

Plaintiff, )

v. )

MITCHELL INTERNATIONAL, INC., )

Defendant. )

Case No. 13cv1523-BEN (BLM)

**NOTICE REGARDING STATUS  
OF PROCEEDINGS IN PATENT  
AND TRADEMARK OFFICE AND  
FEDERAL CIRCUIT APPEAL**

1 Plaintiff Audatex hereby provides notice to this Court regarding the status of  
 2 the Covered Business Method (“CBM”) proceedings in the U.S. Patent and  
 3 Trademark Office (“PTO”) for the patents asserted by Audatex against Mitchell in  
 4 this litigation: U.S. Pat. Nos. 7,912,740 (“the ‘740 patent”), 8,200,513 (“the ‘513  
 5 patent”), and 8,468,038 (“the ‘038 patent”). As indicated in an earlier notice filed  
 6 with the Court, the PTO has issued written decisions for all three of the Audatex  
 7 patents finding the challenged claims unpatentable. Dkt. No. 207 at 1.

8 On April 22, 2016, Audatex filed notices of appeal seeking appellate review  
 9 by the Federal Circuit with respect to the PTO decisions for the ‘740 and ‘038  
 10 patents. *See* Ex. A (Notice of Appeal: ‘740 Patent); Ex. B (Notice of Appeal: ‘038  
 11 Patent). Audatex did not file a notice of appeal with respect to the ‘513 patent.

12 Pursuant to 35 U.S.C. § 143 and Fed. Cir. Rule 17(b)(1), the PTO Director  
 13 will send to the Federal Circuit the certified list and a copy of the decisions to be  
 14 reviewed within 40 days. Docketing, briefing, and oral argument on the appeal will  
 15 be scheduled thereafter. *See* Fed. Cir. Rules 15(b), 31, 34(b), 47.3 & 47.4.

16 No certificate may be issued cancelling any claim of the ‘740 and ‘038  
 17 patents while the Federal Circuit appeal is pending. 37 C.F.R. § 42.80 (“a certificate  
 18 cancelling any claim of the patent finally determined to be unpatentable” will be  
 19 issued and published only “[a]fter ... the time for appeal has expired or any appeal  
 20 has terminated”).

21 Dated: April 25, 2016

Respectfully submitted,

IRELL & MANELLA LLP

23 *By: /s/ Kamran Vakili*

Morgan Chu (#70446)

mchu@irell.com

1800 Avenue of the Stars, Suite 900

Los Angeles, CA 90067

Telephone: (310) 277-1010

Facsimile: (310) 203-7199

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

David C. McPhie (#231520)  
dmcphie@irell.com  
Kamran Vakili (#284441)  
kvakili@irell.com  
840 Newport Center Drive, Suite 400  
Newport Beach, CA 92660  
Telephone: (949) 760-0991  
Facsimile: (949) 760-5200

*Attorneys for Plaintiff Audatex North  
America, Inc.*

**PROOF OF SERVICE**

I am employed in the County of Orange, State of California. I am over the age of 18 and not a party to the within action. My business address is 840 Newport Center Drive, Suite 400, Newport Beach, California 92660-6324.

On April 25, 2016, I served the foregoing document described as NOTICE REGARDING STATUS OF PROCEEDINGS IN PATENT AND TRADEMARK OFFICE AND FEDERAL CIRCUIT APPEAL on each interested party, as follows:

☒ (BY E-FILE): I caused such documents to be transmitted by e-file with the Clerk of the Court by using the CM/ECF system, which will send a notice of electronic filing to the following:

PAUL, PLEVIN, SULLIVAN & CONNAUGHTON LLP

Fred M. Plevin

fplevin@paulplevin.com

101 West Broadway, Ninth Floor

San Diego, CA 92101

Tel: (619) 744-3650

MORGAN, LEWIS & BOCKIUS LLP

Jason C. White

jwhite@morganlewis.com

Scott Shutte

sshutte@morganlewis.com

Tedd Warden

twarden@morganlewis.com

77 West Wacker Drive

Chicago, IL 60601

Tel: (312) 324-1000

Lorraine Casto

lcasto@morganlewis.com

One Market, Spear Street Tower

San Francisco, CA 94105

Tel: (415) 442-1216

*Attorneys for Defendant Mitchell International, Inc.*

Executed on April 25, 2016, at Newport Beach, California.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Kamran Vakili

(Type or print name)

/s/ Kamran Vakili

(Signature)